REMARKS

Claims 1-10, 16-17, and 20-49 are pending in the application. Claims 42-49 have been added. No new matter is added. Reconsideration in light of the following arguments is respectfully requested and allowance is earnestly solicited.

Claim Rejection 35 U.S.C. § 102(e)

35 U.S.C. § 102(e)

Claims 1, 2, 8-10, 16-17, 25, 32, and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Cheston et al., United States Patent Number 6,167,494, hereinafter *Cheston*. Applicants respectfully disagree.

Regarding Claims 1 and 16, Claims 1 and 16 have been amended to more particularly point out and distinctly claim the present invention. Claims 1 and 16 are amended to point out configuration data primarily includes of at least one of hardware and software configuration data. In contrast, *Cheston* discloses storing a mirrored copy of substantially all data which includes data not associated with hardware and software configuration data. Removal of the rejection under 35 U.S.C. §102(e) to Claims 1, and 9 is respectfully requested and allowance is solicited.

With regard to the anticipation rejection under 35 U.S.C. §102(e) of Claims 1, 2, 8-10, 16, 17, 25, 32, and 34, the Office asserted that *Cheston* anticipates the present invention. Applicants disagree. "[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984)) (emphasis added).

With particular regard to the pending rejection under 35 U.S.C. §102(e) to Claims 1 and 16, *Cheston* discloses a method which includes establishing a partition, copying substantially all of the data from a first segment to a second segment which is at least the

same storage capacity as the first segment, and backing up substantially all the data from the first partition to the second partition. This is not the present invention.

First, *Cheston* notes repeatedly that "substantially all of the data" stored in the first segment must be copied to the second segment. *See Cheston* Col. 2, line 48; Col. 2, lines 51-52; Col. 3, lines 33-37; Col. 3 lines 48-49; Col. 3, lines 52-53; Col 5, lines 4-7 (referring to the sectors forming the data); Col. 6, lines 8-10 (referring to the physical size of the segments). In fact, *Cheston* teaches that "substantially" all the data must be backed-up whether the data is configuration data or not (thus the need for a second segment at least equal to the first). *Cheston*, Col. 6, lines 9-10. In contrast, the present invention is directed (generally) to a method wherein configuration data (which may include hardware driver data and software configuration data) is backed-up and is subsequently accessible via a non-interactive user input. The present invention is additionally advantageous because the demand on the storage system is minimized over the method disclosed in *Cheston.*

Additionally, the Cheston patent does not teach to "restore the known-good configuration via non-interactive input" as recited in the claim. The Cheston patent requires that the operating system preferably is not running, or that the user reboot the computer to replace the operating system with restoration code. (Cheston, col. 3, lines 19-26). Thus, the Cheston patent does not teach or suggest to restore the known-good updated combination configuration. Instead, Cheston causes "the computer to re-boot the operating system, the operating system initialization code being replaced by the restoration code."

Further, upon reading *Cheston* one would be informed that it is necessary to back-up all data into a segmented section in order to conduct a restoration. Once again, this is not the present invention. In contrast to *Cheston*, with reference to Claim 1, configuration data is stored and subsequently restored via non-interactive user input. *Cheston* fails to teach this step. Further, *Cheston* teaches, upon "invoking" a restoration function by means of a combination of keys, data other than configuration data may be implemented from the

back-up. Col. 2, lines 51-52. Thus, in *Cheston*, all data from the second segment is "known-good data" which includes data not related to configuration data. Further, in *Cheston*, upon depressing a combination of keys random data may be restored essentially from a mirrored segment of the drive. This is not the present invention. In contrast, the present invention teaches known-good configuration data may be restored upon execution of a non-interactive user input. Thus, *Cheston* fails to teach the methods as recited.

Additionally, *Cheston* fails to teach the steps of the current invention. For example, upon reading *Cheston* one would be directed to store data other than configuration data and subsequently would restore data other than configuration data. Removal of the rejection under 35 U.S.C. §102(e) to Claims 1, 2, 8-10, 16, 17, 25, 32, and 34 is respectfully requested and allowance is solicited.

Claims 2, 8, and 25 are believed to be allowable based on their dependence from Claim 1. Removal of the pending rejection is respectfully requested.

Regarding Claim 9, Claim 9 has been amended to more particularly point out and distinctly claim the present invention. In light of the foregoing removal of the pending rejection is requested and allowance solicited.

Claims 10 and 34 are believed to be allowable based on their dependence from Claim 9. In light of the foregoing removal of the pending rejection is requested and allowance solicited.

Claims 17 and 32 are believed to be allowable based on their dependence from Claim 16. Argued above. Removal of the pending rejection is respectfully requested.

Claim Rejection 35 U.S.C. § 103(a)

35 U.S.C. § 103(a)

Claims 3-7, 20-24, 26-31, 33, and 35-41 stand rejected as obvious under 35 U.S.C. § 103(a) in view of *Cheston*. Applicants respectfully disagree.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.,* 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Regarding the pending rejection to Claims 3-6 under 35 U.S.C. § 103(a), Applicants respectfully traverse the rejection. *Cheston* fails to teach the invention recited in Claims 3-6.

Regarding the pending rejection under 35 U.S.C. § 103(a) to Claim 7, the Office asserts that "it is a matter of design choice" to store an incremental configuration change rather than performing an all inclusive back-up. Applicants disagree. As noted previously, the cited reference must be considered as a whole when applying an obviousness rejection. As argued previously, in the present case the *Cheston* reference teaches that all data must be backed up. Thus, upon reading *Cheston* one would be directed to partition the non-volatile storage and then conduct a full back-up. The Office fails to cite a source of this matter of design choice. Applicants disagree. Specifically, *Cheston* is directed to a method wherein substantially all the data is stored in a partitioned segment. This is required so that no interpretation of the data is required. *Cheston*, Col 5, lines 8-10. Thus, the method requires that substantially all the data be stored so that a restoration function may be implemented.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

> suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

As the Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying the *Cheston* reference to achieve the present invention wherein an incremental storage occurs. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Office, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Regarding the pending rejection of Claims 20, 21, 27, and 28, the Office asserts "Obviously, Cheston's system receives an indication that the special key combination has been actuated and restoring the known-good configuration thereafter." Applicants traverses the rejection. With regard to Claims 21 and 28, *Cheston* fails to teach restoring the known-good configuration without having to reboot the computer. In particular, *Cheston* recites several times that it is preferable that no operating system is running. *Cheston*, Col. 3, line 19. In light of these comment, *Cheston* fails to disclose an instant where the operating system is running while the restoration occurs sufficient to enable one

to conduct the method which was asserted by the Office as disclosed. In light of the foregoing removal of the pending rejection under 35 U.S.C. §103(a) is requested and allowance solicited.

Regarding the rejection of Claims 22-24 and 29-31, the Office cited *Cheston* Col 5, lines 17-21 for the proposition that *Cheston* discloses prompting a user to store the known-good configuration. Applicants disagree. *Cheston* Col. 5 lines 17-21 states "The end user should only perform such a backup when he/she knows that the first half of the disk contains 'good' data. Suitable times when the first half of the disk is known to contain 'good', data are immediately after the system is first installed or immediately after a successful bootup." Neither the cited portion nor anywhere does *Cheston* teach prompting the user to store the known-good data. The cite portion merely states that this is a good time to store data rather than providing a prompt such as visual indication that a storing action will occur or prompting the user to store the known-good configuration. In light of the foregoing removal of the pending rejection under 35 U.S.C. §103(a) is requested and allowance solicited.

Regarding the rejection to Claim 35, Claim 35 has been amended to more particularly claim the present invention. To wit, Claim 35 has been amended to point out that the restoration becomes effective (operable) without having to reboot the computer. *Cheston* fails to provide one instance wherein the restorative function is conducted and the system becomes operable without rebooting the system. In light of the foregoing removal of the pending rejection under 35 U.S.C. §103(a) is requested and allowance solicited.

Regarding the rejection to Claim 36, the Cheston patent does not teach to "restor[e] the known-good updated combination configuration upon reception of the non-interactive user input," as recited in claim 36. The Cheston patent requires that the operating system preferably is not running, or that the user reboot the computer to replace the operating system with restoration code. (Cheston, col. 3, lines 19-26). Thus, the Cheston patent does

not teach or suggest to restore the known-good updated combination configuration. Instead, Cheston causes "the computer to re-boot the operating system, the operating system initialization code being replaced by the restoration code." Removal of the pending rejection under 35 U.S.C. §103(a) is requested and allowance solicited.

Regarding the rejection to Claim 37, it appears that the relied upon passage of the Cheston patent pertains to the backup process, not the restoration function. As mentioned above, the Cheston patent requires that the operating system preferably not be running or that the user reboot the computer. Further, *Cheston* fails to provide one instance wherein the restorative function is conducted and the system becomes operable without rebooting the system. In light of the foregoing removal of the pending rejection under 35 U.S.C. §103(a) is requested and allowance solicited.

CONCLUSIONS

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

DATED: October 14, 2003.

Respectfully submitted,

Gateway, Inc.

By _____

Nathan T. Grebasch
Reg. No: 48,600

SUITER & ASSOCIATES PC
14301 FNB Parkway, Suite 220
Omaha, NE 68154-5299
Telephone: (402) 496-0300
Facsimile: (402) 496-0333